Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL RODMAN HICKS

Appeal No. 2002-1324
Application No. 09/024,111

ON BRIEF

Before HAIRSTON, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-69, all of the pending claims.

The invention is directed to the use of file attributes to associate one computer program with another. A second set of program code is generated from a first set of program code and the second set of program code is associated with a retrieved file using a file attribute.

Representative independent claim 1 is reproduced as follows:

1. A method of retrieving a program for execution on a computer system, the program stored in a file on the computer system and including a first set of program code, the method comprising:

(a) retrieving the file;

(b) generating a second set of program code from the first set of program code; and

(c) associating the second set of program code with the file using a file attribute.

The examiner relies on the following reference:

Schwartz et al. [Schwartz] 5,047,918 Sep. 10, 1991

Claims 1-69 stand rejected under 35 U.S.C. § 102 (b) as anticipated by Schwartz.

Reference is made to the brief (supplemental brief-Paper No. 12-June 22, 2001) and answer (Paper No. 13) for the respective positions of appellant and the examiner.

OPINION

Under 35 U.S.C. § 102 (b), anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is the examiner's position that the abstract, title and column 1, lines 8-35 of Schwartz teaches the subject matter of the preamble and the "retrieving the file" of instant claim 1. With regard to the claimed "generating a second set of program code from the first set of program code," the examiner alleges that this is "inherent" in Schwartz. The examiner points to the "ripple effect" disclosure in column 1 of Schwartz, and particularly refers to "changes to related documents." Finally, the examiner identifies column 1, lines 36-66, and column 2, lines 9-14, of Schwartz as the claimed "associating the second set of program code with the file using a file attribute."

While we appreciate the examiner's efforts to particularly identify portions of Schwartz allegedly corresponding to the claimed elements, we do not agree with the examiner's assessment. In particular, while the examiner apparently is equating the data "files" of Schwartz with the claimed sets of "program code," data files are not sets of program code and, in our view, it is not reasonable to allege that they are identical.

Since Schwartz does not disclose any type of "program code," it is unreasonable to conclude that the reference discloses or suggests the claimed generation of a second set of program code from a first set of program code. Moreover, the examiner's allegation of "inherency" is not well founded since inherency means that the alleged function *must*, of necessity, occur. A finding of inherency cannot be based on speculation and/or a finding that something *might* happen.

Accordingly, since, in our view, the examiner has not set forth a prima facie case of anticipation, we will not sustain the rejection of claims 1-69 under 35 U.S.C. § 102(b).

The examiner's decision is reversed.

REVERSED

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| KENNETH W. HAIRSTON<br>Administrative Patent Judge | ) |
| ERROL A. KRASS<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS<br>) AND<br>) INTERFERENCES |
| JERRY SMITH<br>Administrative Patent Judge | ) |

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